

REMARKS

Claims 1-28 were pending in the application. In response to the office action, applicants have canceled claims 26-28 and amended claims 1, 2, 5, 6, 9, 12, 13, 16, 18, and 22. Claims 1-25 are now pending for reconsideration.

Claims 9 was objected to because of informalities. Applicants wish to thank the Examiner for his careful review of the claims and have amended claim 9 editorially in accordance with the Examiner's guidance. No claim scope or equivalents are surrendered by way of these editorial amendments.

In numbered paragraph 4, the office action states that applicant's prior arguments were considered moot in view of the new grounds of rejection. However, the grounds of rejection for claims 17-21 and 24-25 have not changed. MPEP § 707.07(f) provides that "[w]here the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it." Accordingly, the Examiner should have responded to the substance of applicants' prior arguments.

MPEP § 706 states that "[t]he goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity." Because the office action does not set forth the Examiner's position with respect to applicants' prior arguments, the applicants' have little choice but to repeat those arguments without knowing the Examiner's position, thus being deprived of a fair opportunity to provide evidence or reply completely at the earliest opportunity. If the rejection of any of claims 17-21 or 25-25 over Miller is maintained, applicants respectfully request a new non-final action so that applicants have a fair opportunity to reply.

Claims 1-8, 12-21 and 24-28 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,308,265 (Miller). Claim 9 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Miller in view of U.S. Patent No. 5,960,445 (Tamori). Claims 10-11 and 22-23 are rejected as being unpatentable over Miller. Applicants respectfully traverse these rejections for the following reasons.

Applicants first note that the office appears to have an editorial error in the §102 rejection, identifying 'Miller' in the rejection followed by U.S. Patent No. 5,960,445 (which is the Tamori reference). Applicants note that the substance of the rejection is clearly referring to U.S. Patent No. 6,308,265.

Applicants have amended claims 1, 6, and 12 to more clearly distinguish over the Miller reference. Specifically, applicants have clarified that some embodiments of the invention involve modifying an address bit in the execution address and maintaining the state of the address bit during a power cycle. Each of the independent claims now recites features relating to modifying an address bit of the execution address and maintaining the state of the address bit during a power cycle. Miller does not teach or suggest these features.

In order to anticipate, the reference must identically describe what is recited in the claims. As admitted in the office action, Miller discloses only setting a flag when a boot block is being update (see Miller at col. 5, lines 65-67). The setting of a flag is different from and does not teach or suggest modifying an address bit of the execution address.

For example, some implementations of the invention may have advantages over the flag utilized in Miller. As described in connection with Fig. 4 of Miller, additional parts and operations are required to utilize the flag. Some implementations of the present invention may omit or reduce the number of extra parts or operations required by modifying and maintaining the state of the address bit of the execution address.

The office action further relies on the flag for allegedly reading on the recited maintaining the state of the address bit during a power cycle. Even assuming for the sake of argument, that the flag described in Miller corresponds in some way to modifying a bit of the execution address, it is clear that only the state of the flag is maintained in Miller. Miller does not describe that the state of the address bit is maintained during a power cycle.

Because Miller does not teach or suggest modifying an address bit of the execution address and maintaining the state of the address bit during a power cycle, each of independent claims 1, 6, 12, 17, 20, and 24 are each not anticipated by and are patentable over Miller. The respective dependent claims 2-5, 7-11, 13-16, 18-19, 21-23, and 25 are likewise patentable.

With respect to claim 9, Tamori, which is relied on for other features, fails to make up for the deficiencies in Miller.

With respect to claims 10-11 and 22-23, applicants first note that the office action incorrectly asserts that "Miller teaches maintaining the state of an address bit (sticky bit) following a power cycle" (emphasis added). As discussed above, Miller at most teaches maintaining the state of a flag (the sticky bit), not an address bit. The office action then admits that Miller is silent with respect to the recitations of claims 10-11, but asserts, without support from the Miller reference, that such modifications to Miller would be obvious. The Examiner appears to be relying on an inherency argument. However, as the Examiner is well aware, numerous forms of non-volatile circuits are well known in the art to preserve the state of a flag bit upon power failure. Accordingly, it is not inherent or obvious that Miller would practice the particular recitations of claims 10-11. The only motivation to modify Miller in the manner suggested in the office action, appears to come impermissibly from the teachings of the present specification.

If the rejection is maintained, applicants respectfully request that the Examiner fully answer the substance of applicants traversal. Specifically, to create a clear record for appeal, applicants respectfully request that the Examiner state for the record whether it is the position of the Examiner that the 'flag' disclosed in Miller identically describes the recited address bit of an execution address.

In view of the foregoing, favorable reconsideration and withdrawal of the rejections is respectfully requested. Early notification of the same is earnestly solicited. If there are any questions regarding the present application, the Examiner is invited to contact the undersigned attorney at the telephone number listed below.

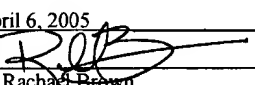
Respectfully submitted,

April 6, 2005

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Signature <u></u>	<u>4/6/05</u>
Rachael Brown	Date